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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,963	09/27/2000	Daoqiang Lu	GTRC40	1376

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/13/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/671,963

Applicant(s)

LU ET AL.

Examiner

Robert Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 6, 8 and 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 9, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Claims 10-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7. Claims 6 and 8 are withdrawn as being directed to non-elected species.

The 35 U.S.C. 103(a) rejection over Wang et al., Japanese Patent No. 50-352232, Soviet Union Patent No. 1,628,508 and Saito et al. Patent No. 4,845,136 in view of Eadara and Vincent et al. is rescinded because the epoxide-modified polyurethane structure of claim 2 has been inserted into claim 1. The epoxide-modified polyurethanes of Wang et al., the Japanese and Soviet Union patents and Saito et al. wherein an isocyanate prepolymer is reacted with the epoxy groups of an epoxy resin yields a structurally distinct polymer from that of the claimed structure wherein an isocyanate prepolymer is reacted with a compound with active hydrogen and at least one epoxide group (specification, page 13, lines 3-7 and 16-21) such as glycidol or glycerol diglycidyl ether (page 13, lines 26-27).

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-5, 7, 9, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuri et al., Saito et al. '502, Lohse and Japanese '882, '877 and '052 in view of Eadara and the Vincent et al. article.

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The rejection is maintained for the reasons of record set forth in the previous Office action. The arguments filed September 9, 2002 have been considered but are unpersuasive.

The claimed adhesive "comprising" an epoxide-modified polyurethane, crosslinking agent, adhesion promotor and conductive filler does not preclude the rubber-modified epoxy resin of Okuri et al., the bisphenol epoxy resin of Saito et al., or the additional epoxy resin of the Japanese patents.

Okuri et al. (col. 5, lines 33-35) espouses an electroconductive carbon black filler which is a suitable species according to claim 8 and page 4, line 25 of the specification.

The motivation to incorporate an epoxy-functional silane as an adhesion promotor in the adhesives of Okuri et al., Saito et al., Lohse and the Japanese patents is explicitly recognized in Eadara (col. 2, lines 45-46) and Vincent et al. (page 7, first column, lines 8-9). The epoxy silane adhesion promotor of Eadara is useful in adhesives containing epoxy-terminated polyurethanes. Accordingly, it would have been obvious to incorporate the epoxy silane of Eadara and Vincent et al. in the adhesives of Okuri et al., Saito et al., Lohse and the Japanese patents in order to promote the adhesion since the primary references are directed to adhesives and Eadara establishes the use of epoxy silane adhesion promoters with epoxy-terminated polyurethanes.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

(703) 308-2399 (Fax no. (703) 872-9311)
Monday to Friday from 9:30 to 6:00 EST

Robert Sellers
Primary Examiner
Art Unit 1712

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9/12/02